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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appln. No.	: 09/897,295	Confirmation No. 1994
Applicant	: William J. Boyle et al.	
Filed	: June 29, 2001	
Title	: DELIVERY AND RECOVERY SHEATHS FOR MEDICAL DEVICES	
Art Unit	: 3743	
Examiner	: Mitchell, Teena Kay	
Docket No.:	: ACSES 56001 (G2636USO1)	
Customer No.	: 24201	January 23, 2008

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

REPLY TO THE EXAMINER'S ANSWER

Dear Sir:

This Reply Brief is being filed in response to the Examiner's Answer dated October 24, 2007. Please charge any fees due in connection with the filing of this Reply Brief to our Deposit Account no. 06-2425.

## **INTRODUCTION**

### **I. STATUS OF CLAIMS**

The status of the claims in this application is:

#### **A. Total Number of Claims in the Application**

The claims in the application are: Claims 3-13, 20-26 and 41-51.

#### **B. Status of All of the Claims**

Claims 3-13, 20-26 and 41-51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,544,279 to Hopkins et al. (the "Hopkins patent") in view of U.S. Patent No. 6,123,715 to Amplatz (the "Amplatz patent") and U.S. Patent No. 6,517,765 to Kelley (the "Kelley patent").

#### **C. Claims on Appeal**

The claims on appeal are each of pending claims 3-13, 20-26 and 41-51.

## **II. GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Whether claims 3-13, 20-26 and 41-51 were improperly rejected under 35 U.S.C. § 103(a) over the Hopkins patent in view of the Amplatz patent and the Kelley patent.

### **III. ARGUMENT**

Appellant submits that the Examiner has used impermissible hindsight to recreate Appellant's presently claimed invention. The Examiner has simply used the pending claims as a roadmap in order to selectively pick and choose prior art which allegedly shows all of the elements recited in the pending claims. However, in doing so, the Examiner has completely disregarded the teachings of the primary reference, namely the Hopkins patent, and has selected secondary references which, even when combined with the primary reference, fail to achieve the structure recited in the pending claims.

The Examiner has simply selected the Hopkins patent as the primary reference because the Hopkins patent discloses a housing portion made primarily from an elastic material which is movable between a contracted position and expanded position. Contrary to the Examiner's statement at page 9, lines 13-15 of the Examiner's Answer, Appellant is not claiming that the Hopkins patent fails to disclose the use of a housing portion made from an elastic material. Rather, Appellant's position regarding the Hopkins patent is that the housing portion of the Hopkins device is made with sufficient column strength to capture the filter **580** and there would be no reason to add the tubular braids disclosed in the secondary references to provide additional column strength. The embodiments disclosed in the Hopkins patent clearly show that the housing portion is made with sufficient column strength to capture the filter **580**. Reference is again made to Figure 23B of the Hopkins patent which clearly shows that the distal end region **594** of the retrieval sheath **592** remains "unbunched" after being radially stretched by the expander **590**. The end region **594** of the retrieval sheath **592** must possess sufficient column strength in order to allow the expander **590** to move within the opening to radially expand the tubing. Otherwise, if this end region **594** did not possess enough column strength, then the end region **594** would "bunch" upon

itself, much like the bellows of an accordion, when the expander **590** contacts the end region **594** and applies an axial force.

The Hawkins patent thus fails to disclose the need for **any** reinforcing member with its housing portion since the housing portion already possesses sufficient column strength to retrieve the filter **580**. Therefore, one skilled in the art reading the Hopkins patent would **see no need or reason** to increase the column strength of the housing portion **592** with any type of reinforcing member. Accordingly, there is no teaching, suggestion or motivation for one skilled in the art to add a reinforcing member to the housing portion of the Hopkins device.

Again, even assuming *arguendo* that one skilled in the art would read the Hopkins patent and determine that additional column strength would be needed, the Examiner's reliance on the Amplatz patent and Kelley patent to supply the reinforcing members fails to achieve the structure recited in the pending claims. Claims 3 and 41 require the reinforcing member to increase the column strength of the housing portion **without** interfering with the expansion or contraction of the housing portion. In order to capture the filter, the housing portion must expand radially outwardly to initially cover the filter and then it must contract to collapse the filter back down to its smaller profile. The use of the metal fabric or braiding disclosed in the secondary references would certainly interfere with the housing's ability to expand outwardly to collect the filter. Tubular braids have been used to reinforce the wall of the guiding catheter since the intertwining braid geometry is designed to inhibit expansion and collapse, but will provide the needed lateral or longitudinal flexibility to the guiding catheter. Simply put, the use of a woven braid with an expandable housing would inhibit radial contraction and expansion of the housing. Therefore, the combination of the Hopkins patent with the Amplatz and Kelley patents simply fails to create the structure recited in the pending claims.

In summation, the Examiner has simply used the pending claims as a roadmap to select prior art references which allegedly show the elements recited in the pending claims. The Hopkins patent simply fails to provide any teaching, suggestion or motivation to utilize reinforcing members in its housing portion. The Amplatz and Kelley patents only disclose structural elements which would inhibit expansion and collapse of a housing portion. Thus, one skilled in the art would not combine the references suggested by the Examiner and further the suggested combination of these patents would not even create the structure recited in the pending claims.

#### **IV. CONCLUSION**

For the foregoing reasons, it is submitted that the present invention as claimed is not unpatentable over the Hopkins patent in view of the Amplatz and Kelley patents and the Examiner's rejection of claims 3-13, 20-26 and 41-51 was erroneous.

Respectfully submitted,

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